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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/911,333 | 07/23/2001 | Ming Ye | CL/V-31556PI/CVA | 2766 |

1095 7590 09/11/2003

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| EXAMINER |
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SCHWARTZ, JORDAN MARC

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2873

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,333

Applicant(s)

YE ET AL.

Examiner

Jordan M. Schwartz

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-8 and 15-29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I, claims 1-8 in Paper No. 3 is acknowledged. New claims 15-29 have been grouped together with the claims of Group I. Therefore, claims 1-8 and 15-29 have been examined herein.

Information Disclosure Statement

The information disclosure statement filed June 24, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, a concise explanation for the foreign reference FR-2 582 416 was not provided and therefore this reference has been crossed out and has not been considered.

For applicant's further information, the reference "International Search Report" listed on the IDS of June 24, 2003 was crossed out because this reference is already listed on the IDS of April 18, 2002.

Claim Objections

Claims 2, 5, and 18-21 (and respective dependent claims 3-4, 6-8, 15-17, 22-29) are objected to for the following reasons. Since the intended meaning could be determined from the specification and the Figures, 112 rejections were not made but instead these lack of clarity issues were raised in the following claim objections:

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1. In reference to claim 2, part (d), "the ridge-off zone" lacks an antecedent basis and it is suggested that it be changed to "a ridge-off zone" (the assumed meaning);

In reference to claims 5, and 18-21 that part of the claim stating "further comprising a ridge-off zone" creates a lack of clarity since the ridge-off zone is already claimed in claim 2. It is suggested that "the contact lens further comprising a ridge-off zone extending" be changed to "wherein said ridge-off zone extends" (which is the assumed meaning).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volker et al.

Volker et al discloses the limitations therein including the following: a contact lens comprising a bifocal optical zone (Figure 1, "22" and "23", column 5, line 8); a transition zone (Figures 1, 3, 4 and 6, column 4, lines 43-53 re "transition zone "6"); the transition zone depending downwardly from the bifocal optical zone (Figures 1 and 4 re that portion of zone "6" which extends concentrically around the lens that is below the bifocal zone); a ridge zone depending downwardly from the transitional zone including a

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latitudinal ridge portion that extends outwardly from the outer surface (Figures 1 and 3, re "12" positioned below the transition zone); the ridge portion having a shape to engage with a lower eyelid to provide vertical translation support (column 3, line 66 to column 4, line 53). Volker et al discloses as is set forth above but does not disclose the specific material of the contact lens i.e. does not disclose that the lens comprises a soft contact lens material. However, the examiner takes Judicial Notice that it is well known in the art of contact lenses for such lenses to be made of soft contact lens material to provide lenses of greater comfort and increased oxygen permeability. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the lens of Volker et al as being made of a soft contact lens material since it is well known in the art of contact lenses for such lenses to be made of soft contact lens material to provide lenses of greater comfort and increased oxygen permeability.

Allowable Subject Matter

Claims 2-8 and 15-29 are allowed (upon overcoming the objections above).

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach the claimed combination of limitations. Specifically, with reference to independent claim 2, none of the prior art either alone or in combination disclose or teach of the claimed contact lens having an optical zone, ridge zone, transition zone, and a bevel zone, all having the specific structure and locations as claimed.

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Examiner's Comments

Ezekiel application number 2003/0095231 and WO 01/44860 would both read on claim 1, however, neither qualify as prior art. Webb is being cited herein to show a bifocal contact lens having some similar structure to that of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
August 29, 2003